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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,731

07/05/2005

E Lucile White

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23859

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04/28/2009

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

04/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,731	Applicant(s) WHITE ET AL.	
	Examiner Kailash C. Srivastava	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-26,30,31 and 36-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29 and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13 February 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

General Informal Matters

1. The response, amendment and remarks filed 13 February 2009 to the Office Action mailed 26 September 2008 is acknowledged and entered.
2. This application contains claims 1-26, 30-31 and 36-42 drawn to an invention non-elected without traverse in the replies filed respectively on 05 February and 20 May 2008 in response to Office Actions mailed respectively on 24 October 2007 and 09 May 2008. A complete reply to the instant final rejection must include cancellation of said non-elected claims or other appropriate action (See, 37 C.F.R. §1.144 and M.P.E.P. §821.01).

Withdrawals in View of Applicants' Arguments/Remarks

3. In view of remarks, supplementary documentation and amendment filed 13 February 2009; following objections and rejections in the Office Action mailed 26 September 2008 are hereby withdrawn:
 - Objection to Information Disclosure Statement filed 05 July 2005 regarding incomplete recitation for references A73-A74 and A76;
 - Objection to specification for not reciting application priority information regarding PCT/US03/20984 filed 02 July 2003.
 - Objection to Claim 27; and
 - Indefiniteness rejection to Claims 27-29 and 32-35 under 35 U.S.C. §112, 2nd paragraph.

Claims Status

4. Claims 1-42 are currently pending.
5. Claims 1-26, 30-31 and 36-42 currently remain withdrawn.
6. Claims 27-29 and 33 have currently been amended.
7. Claims 27-29 and 32-35 are currently under examination and are examined on merits.

Priority

8. In the Office Action mailed 26 September 2008, applicants' Claim for priority to following applications: U.S. Provisional application Serial Number 60/393,680 filed 02 July 2002 and PCT/US03/20984 filed 02 July 2003 is acknowledged. Mere acknowledgement to priority, however, does not grant benefit of a priority date. A separate analysis is required to grant benefit of priority date. Said analysis requires complete review and side-by-side comparison of the Claims and specification recited in said Provisional application filed 02 July 2002 vis-à-vis Claims and specification of the instant National stage Non-Provisional application with a filing date of 05 July 2005. Said comparison is as follows:

US PROVISIONAL APPLICATION NUMBER 60/393,080 FILED 02 JULY 2002	INSTANT NON-PROVISIONAL APPLICATION- 371 OF PCT/US03/20984 FILED 02 JULY 2003
Claims: Only one Claim presented. "A method of treatment essentially as described herein". No structure given.	Claims: Claim 27 is drawn to a method of inhibiting FtsZ polymerization in a bacterium comprising contacting the bacterium with an effective amount of one or more compounds having the structure: Generic structure given
Specification: The Specification including Claims totals 43 Pages. No structures are given in the specification. Description of only 8 Figures is given (See Page 5, Line 19 to Page 6, Line 21). Only 4 Tables are given, among which e.g., contents given in Table 2 match with Table 5 and Table 4 match with Table 4 of 371 application,	Specification: The Specification excluding Claims page, totals 92 Pages. Structures are given in the specification (See, e.g., Page 18, Line 1; Page 28, Lines 8-9 & 14; Page 29, Line 6; Page 30, Line 18; Page 31, Lines 1, 5, 8, 11; Page 32, Lines 4, 7, 10 and 13). Description of 9 Figures is given (See Page 3, Line 15 to Page 4, Line 21). At least 8 tables are given.

In view of the comparison discussed above, some of the features taken as example (e.g., structures) that are absent in the provisional application (i.e., US Provisional Application Number 60/393,080 filed 02 July 2002), but are present in the Claims as well as the specification of the instant Non- Provisional

US Application Number 10/519,731 filed 05 July 2005. Accordingly, in view of the fact that the disclosure of the instant Non- Provisional US Application Number 10/519,731 is similar to the disclosure of PCT/US03/20984; the benefit of Priority date granted to the instant Non- Provisional US Application Number 10/519,731 is the filing date of 02 JULY 2003, which is the filing date of PCT/US03/20984.

Information Disclosure Statement

9. The Information Disclosure Statement (i.e., IDS) filed 13 February 2009 is acknowledged, has been made of record, considered and dully signed appropriate USPTO form is enclosed with the instant Office Action.

Claim Rejections - 35 U.S.C. §103

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

12. Claims 27-29 and 32-35 are rejected under 35 U.S.C. §103 (a) as obvious over combined teachings from White et al., (2000. Slow Polymerization of *Mycobacterium tuberculosis* FtsZ, Journal of Bacteriology, Volume 182, Pages 4028-4034, Cited in Applicants' IDS filed 07/05/2007) in view of White et al (2002. 2-Alkoxy carbonylaminopyridines: inhibitors of *Mycobacterium tuberculosis* FtsZ, Journal of Antimicrobial Chemotherapy, Volume 50, Pages 111–114, i.e., White et al'2) and further in view of Johnson et al (US Patent 6,319,958 B1).

In response to above-cited rejection in the Office Action mailed 26 September 2008, the presented argument is, "Specifically the White 2 reference is **not** prior art" (See, Remarks, Page 18, Line 15 of the Response filed 13 February 2009). "The White 2 reference was not published before the priority date of the present application. The present application claims the benefit of priority under 35 U.S.C.

§119 (e) to U.S. Provisional Application 60/393,080, filed July 2, 2002. This priority Claim has been acknowledged by the Examiner in the current Office Action (p.3, ¶ 7). The White 2 reference was published in the July 2002, volume 50, issue 1 of *J. Antimicrobial Chemotherapy*. The actual date this particular issue published was **July 5, 2002-three days after Applicant's priority date of July 2, 2002.**" (See, Remarks, Page 18, Line 18-24 of the Response filed 13 February 2009).

As stated under the "Priority" sub-heading at item 8 *supra*, mere acknowledgement to priority in an Office Action does not grant benefit of a priority date. The acknowledgement only means, "the fact that applicant(s) has/have claimed benefit of priority". A separate analysis is required to grant benefit of priority date. Said analysis requires complete review and side-by-side comparison of the Claims and specification recited in said Provisional application filed 02 July 2002 vis-à-vis Claims and specification of the instant National stage Non-Provisional application with a filing date of 05 July 2005. Said comparison has been presented in item 8 *supra*.

In view of the facts discussed above, white 2 is a prior art. Accordingly, the rejection of Claims 27-29 and 32-35 under 35 U.S.C. §103 (a) as obvious over combined teachings from White et al., (2000. Slow Polymerization of *Mycobacterium tuberculosis* FtsZ, Journal of Bacteriology, Volume 182, Pages 4028-4034, Cited in Applicants' IDS filed 07/05/2007) in view of White et al (2002. 2-Alkoxy carbonylaminopyridines: inhibitors of *Mycobacterium tuberculosis* FtsZ, Journal of Antimicrobial Chemotherapy, Volume **50**, Pages 111-114, i.e., White et al'2) and further in view of Johnson et al (US Patent 6,319,958 B1) in the Office Action mailed 26 September 2008 is maintained.

Applicants' arguments filed 13 February 2009 regarding the rejection to Claims 27-29 and 32-35 as obvious over combined teachings from White et al., (2000. Slow Polymerization of *Mycobacterium tuberculosis* FtsZ, Journal of Bacteriology, Volume 182, Pages 4028-4034, Cited in Applicants' IDS filed 07/05/2007) in view of White et al (2002. 2-Alkoxy carbonylaminopyridines: inhibitors of *Mycobacterium tuberculosis* FtsZ, Journal of Antimicrobial Chemotherapy, Volume **50**, Pages 111-114, i.e., White et al'2) and further in view of Johnson et al (US Patent 6,319,958 B1) in the Office Action mailed 26 September 2008 have been fully and carefully considered but are not persuasive for the reasons of record at items 14-16, Pages 5-7 in the Office Action mailed 26 September 2008 and those discussed *supra*. Thus, the rejection of Claims 27-29 and 32-35 as obvious over the combined teachings from White et al., (2000) in view of White et al (2002) and further in view of Johnson et al (US Patent 6,319,958 B1) in the Office Action mailed 26 September 2008 is maintained and adhered to.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. For the aforementioned reasons, no claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kailash C Srivastava/
Examiner, Art Unit 1657

Kailash C. Srivastava
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(571) 272-0923
27 April 2009
/David M. Naff/
Primary Examiner, Art Unit 1657